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ALBERT P. CEFALO AND WILLIAM CRAY
CYMER, INC. LEGAL DEPARTMENT MS/4-2C
17075 THORN MINT COURT
SAN DIEGO, CA 92127

In re Application of:
RICHARD G. MORTON
Serial No.: 09/742,485
Filed: 20 December 2000

Title: ANNEALED COPPER ALLOY
ELECTRODES FOR FLUORINE
CONTAINING GAS DISCHARGE LASERS

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed on January 24, 2005, to withdraw the holding of abandonment of the above-identified application under 37 CFR § 1.181.

The petition to withdraw the holding of abandonment is **GRANTED**.

An Office notice was mailed to petitioners on July 8, 2004, stating that the appeal brief (labeled "Substitute Appeal Brief") filed June 21, 2004 was defective. An amended appeal brief was timely filed on August 9, 2004 (labeled "Second Substitute Appeal Brief"). A Notice of Abandonment was mailed on January 12, 2005, holding the appeal dismissed and the application abandoned due to the expiration of the statutory time period and the amended brief's failure to overcome all of the reasons for noncompliance of which the petitioner was notified in accordance with 37 CFR § 1.192 (d), which states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. *If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.* (italics added)

The appeal brief was found defective for lack of: a “concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters,” as set forth in 37 CFR § 1.192 (c)(5); a “concise statement of the issues presented for review,” as set forth in 37 CFR § 1.192 (c)(6); each argument under a separate heading for each issue on appeal as set forth in 37 CFR § 1.192 (c)(7), and the submitted prior art being submitted in the same appendix as the claims. The second amended appeal brief filed August 9, 2004, was found defective for a lack of conciseness, and inclusion of material not describing the invention found in the claims in the “Summary of Invention” section required by 37 CFR § 1.192 (c)(5) and as described in MPEP § 1206.

Petitioner asserts that the amended appeal brief fully complies with the requirements of MPEP § 1206. To support this assertion, applicant argues that the amended appeal brief was sufficiently concise to satisfy MPEP § 1206.

When an appellant fails to describe the invention as required by 37 CFR § 1.192 (c)(5), the MPEP provides two possible courses of action. In the first course of action, the brief may be treated as non-compliant under 37 CFR § 1.192 (d). Alternatively, the examiner may address deficiencies in the description, and may include a correct summary of the invention if necessary, in the Examiner’s Answer in accordance with MPEP § 1208.

The MPEP discusses rationale for choosing between two similar courses of action in § 1206:

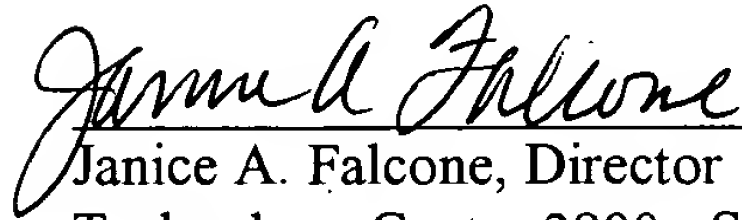
A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, notification of a defective appeal brief is in order, while in the latter case, the application or reexamination is forwarded to the Board for a decision on the merits.

Petitioner’s amended appeal brief appears to be a good faith response satisfying the essential requirements of 37 CFR § 1.192 (c)(5) rather than a lack of a veritable summary of the invention. While the summary of invention may not be as concise as examiner would like, neither is it so long or vague that the Board would be unclear as to the understanding of the claimed subject matter or its location in the specification. The appropriate course of action appears for such matters of conciseness or clarity to be best addressed in an Examiner’s Answer.

The Notice of Abandonment mailed January 12, 2005, is hereby vacated and the holding of abandonment withdrawn. The appeal is reinstated.

The brief will be considered by the examiner, and appropriate action will be taken.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.



Janice A. Falcone, Director
Technology Center 2800 - Semiconductors,
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